

Serial No. 09/825,879  
Docket No. YOR920000070US1

6

### REMARKS

Entry of this Amendment is proper since it narrows the issues on appeal and does not require a further search by the Examiner.

Claims 1-13 and 21-27 are all the claims presently pending in the application. Claims 14-20 have been canceled. Claims 1 and 3 have been amended to more particularly define the invention. Claims 21-27 have been added to claim additional features of the claimed invention.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicant specifically states that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 1-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brick et al. (U. S. Patent No. 6,269,342) in view of Adamec et al. (U.S. Patent No. 5,982,506).

These rejections are respectfully traversed in the following discussion.

#### **I. THE CLAIMED INVENTION**

The claimed invention (as recited, for example, in claim 1) is directed to a system for restocking and repricing merchandise. The system includes a shelf label holder including an illuminating device for performing an illuminating function, and a hand-held unit which remotely causes said illuminating device to illuminate under a predetermined condition.

Importantly, the illuminating device includes a plurality of illuminating sections which correspond respectively to locations on a shelf (Application at Figure 2; page 6, lines 1-18).

Conventional systems for restocking and/or repricing merchandise use an electronic tag which is affixed to the shelf near the merchandise so that the price of the merchandise can be changed electronically. However, these systems are expensive and fragile and do not help to guide the store clerk to a particular shelf location (Application at page 2, lines 3-11).

Serial No. 09/825,879  
Docket No. YOR920000070US1

7

The claimed invention, on the other hand, includes a shelf label holder having an illuminating device which includes a plurality of illuminating sections which correspond respectively to locations on a shelf. This feature may **help guide a store clerk to a correct store location for restocking and/or repricing merchandise** (Application at page 2, lines 13-16).

## II. BRICK AND ADAMEC

The Examiner alleges that Brick would have been combined with Adamec to form the invention of claims 1-13. Applicant submits, however, that these references would not have been combined and even if combined, the alleged combination would not teach or suggest each and every element of the claimed invention.

Brick discloses an electronic pricing and display system which uses programmable electronic shelf tags 10 which are attached directly to a shelf and an apparatus for programming the tags (Brick at Abstract). Each shelf tag is associated with a particular product, and includes an electronic display 26 for displaying pricing information for the product (Brick at col. 4, lines 26-33; col. 12, lines 52-56). A programming device 200 may be used to change the information displayed by the display (Brick at col. 7, lines 60-62).

Adamec discloses a remote control device for an electronic price label (EPL) system. The device 24 includes portions 50a and 50b which include indicators 45a and 45b, respectively (Adamec at Figure 2a; col. 3, line 66-col. 4, line 52). However, Adamec does not state what the indicators 45a and 45b are intended to indicate.

Contrary to the Examiner's allegations, these references would not have been combined to form the claimed invention. Specifically, Brick is directed to a shelf tag associated with a particular product, and Adamec is directed to an EPL system which is intended to allow an operator to control an EPL computer from anywhere in a store (Adamec at col. 2, lines 40-44). Thus, Brick is completely unrelated to Adamec, and no person of ordinary skill in the art would have considered combining these disparate references, absent impermissible hindsight.

Further, Applicant would submit that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed,

Serial No. 09/825,879  
Docket No. YOR920000070US1

8

contrary to the Examiner's allegations, neither of these references teach or suggest their combination. Therefore, Applicant would respectfully submit that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner. Therefore, the Examiner has failed to make a prima facie case of obviousness.

Moreover, neither Brick, nor Adamec, nor any alleged combination thereof teaches or suggests *"wherein said illuminating device comprises a plurality of illuminating sections which correspond respectively to locations on a shelf"*, as recited in claim 1. As noted above, this feature may help guide a store clerk to a correct store location for restocking and/or repricing merchandise (Application at page 2, lines 13-16).

Clearly, the cited references do not teach or suggest this novel feature. Indeed, the Examiner concedes that Brick does not teach or suggest this feature, but alleges that Adamec teaches this feature. The Examiner is clearly incorrect.

Specifically, the Examiner alleges that the indicators 45a and 45b in Adamec provide the illuminating function as in the claimed invention. However, Adamec merely states that these indicators are "preferably an optional alternative or addition to displaying of acknowledgements by displays 46a and 46 b" (Adamec at col. 4, lines 32-34). Adamec states that displays 46a and 46b are used "to signal an operator that EPL computer 12 has executed a desired function in response to a command message from device 24" (Adamec at col. 4, lines 22-24).

Thus, does not clearly state what the indicators 45a and 45b are intended to indicate. Moreover, even assuming that indicators 45a and 45b are intended to perform the same function as 46a and 46b, then indicators 45a and 45b merely signal an operator that EPL computer 12 has executed a desired function in response to a command message.

In fact, Adamec has nothing to do with helping to guide a store clerk to a location for restocking and/or repricing merchandise. Indeed, nowhere does Adamec even teach or suggest a shelf label holder, let alone a shelf label holder which includes an illuminating device having a plurality of illuminating sections which correspond respectively to locations on a shelf.

Therefore, Applicant submits that these references would not have been combined and even if combined, the alleged combination would not teach or suggest each and every element of

Serial No. 09/825,879  
Docket No. YOR920000070US1

9

the claimed invention. Therefore, the Examiner is respectfully requested to withdraw this rejection.

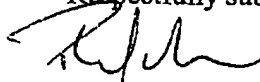
### III. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that claims 1-13 and 21-27, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

Please charge any deficiencies in fees and credit any overpayment of fees to Assignee's Deposit Account No. 50-0510.

Respectfully submitted,



Phillip E. Miller, Esq.  
Registration No.: 46,060

Date: 5/11/05

**McGinn & Gibb, PLLC**  
8321 Old Courthouse Road, Suite 200  
Vienna, VA 22182-3817  
(703) 761-4100  
Customer No. 21254

### CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment was filed by facsimile with the United States Patent and Trademark Office, Examiner Gerald O'Connor, Group Art Unit # 3627 at fax number (703) 872-9306 this 11th day of May, 2005.



Phillip E. Miller  
Reg. No. 46,060